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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/530,838 | 04/08/2005 | Harald Langeder | langeder et al-2 pct | 2450 |

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COLLARD & ROE, P.C.
1077 NORTHERN BOULEVARD
ROSLYN, NY 11576

| EXAMINER | |
|---|---|
| MARKOFF, ALEXANDER | |
| ART UNIT | PAPER NUMBER |
| 1792 | |

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| 09/17/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/530,838 | LANGEDER ET AL. | |
| | Examiner | Art Unit | |
| | Alexander Markoff | 1792 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *04 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-52* is/are pending in the application.

4a) Of the above claim(s) *6-52* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 April 2005* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/1/07, 5/5/05 and 4/8/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of claims 1-5 in the reply filed on 6/4/08 is acknowledged. The traversal is on the ground(s) that the both restricted inventions are directed to the concept requiring the welding torch to be substantially in the same position during liquid application and exposure to electromagnetic field. This is not found persuasive because of the reasons of the record. Further, the invention of Group II does not require the argued concept. The invention of Group II requires the device for applying cleaning liquid and the coil to be in the same housing. The common technical feature, which is present in the claims of the both Groups, is presence of liquid and electromagnetic cleaning was known in the art as evidenced by previously cited US 6,369,357. Moreover, newly discovered US 6,891,127, which is applied in the rejection below, shows that even the concept, which is argued by the applicants was known in the art.

The requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because the scope of the term “substantially in the same position” is not clear in view of claim 5, which requires lowering the welding torch.

Claim 4 is indefinite because the term "the step(s) of … electromagnetic spatter removal” lacks proper antecedent basis.

Claim 5 is indefinite because the term “the position assumed during electromagnetic spatter removal” lacks proper antecedent basis.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Baum et al (US Patent No 6,891,127).

Baum et al teach a method as claimed. See the entire document, especially Figures 1, 2, 4, 5, 5A, 7, 9a-c, 11 and the related description and column 6, lines 33-50.

It is noted that the applied document teaches embodiments of the cleaning where the liquid cleaning and the electromagnetic cleaning are conducted in the same station or in the different stations. Since the indefiniteness of the claims with the respect to the term "substantially in the same position" and since claim 5 clearly requires different positions, the examiner's position is that both embodiments of Baum et al anticipate the claims.

6. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

7. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Baum et al (US Patent No 6,369,357).

Baum et al teach a method as claimed. See the entire document, especially Figures 1, 2, 4, 5, 5A, 7 and the related description and column 5, lines 61-65. It is noted that the applied document teaches the embodiment of the cleaning where the liquid cleaning and the electromagnetic cleaning are conducted in the different stations, which are adjacent to each other. Since the indefiniteness of the claims with the respect to the term "substantially in the same position" and since claim 5 clearly requires different positions, the examiner's position is that both embodiments of Baum et al anticipate the claims, because if the movement between cleaning positions is in the scope of the referenced term, cleaning in two

adjacent cleaning stations shown as part 10 on Figures 1 and 2, meet the limitations of the claims.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Baum et al (US Patent No 6,891,127) and Baum et al (US Patent No 6,369,357) in view of any one of US Patents 4,702,195, 4,778,976, 4,834,280, and 5,138,896.

Both Baum et al patents teach the claimed method except for the use of spraying.

However, it was well-known in the art that spraying is a conventional way for fluid application and is an alternative to immersing.

It would have been obvious to an ordinary artisan at the time the invention was made to use spraying instead of immersion disclosed by Baum et al patents with reasonable expectation of success because it was a conventional method for liquid application and because it was conventionally used in the art of cleaning of welding torches for application of treatment fluids, as evidenced by any one of US Patents 4,702,195, 4,778,976, 4,834,280, and 5,138,896.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No 5,813,074 is cited to show the state of the art with respect to methods for cleaning welding apparatuses.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 571-272-1304. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alexander Markoff
Primary Examiner
Art Unit 1792

/Alexander Markoff/
Primary Examiner, Art Unit 1792